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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/661,878  
Filing Date: September 11, 2003  
Appellant(s): ZILKA ET AL.

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Kevin J. Zilka  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 5/27/08 appealing from the Office action mailed 12/27/07.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

To the best knowledge of the examiner the applications listed by the appellant in the Appeal Brief are correct and complete.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

|              |                |        |
|--------------|----------------|--------|
| 2003/0046307 | Rivette et al. | 3-2003 |
| 2002/0082778 | Barnett et al. | 6-2002 |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-2, 4-13, 18-20 and 44-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has amended the independent claims to include the limitation of displaying statistics regarding a number of the patents of the set in each category of technology ***in a first interface***, displaying first additional information associated with at

least a portion of the patents of the set ***in a second interface separate from the first interface*** upon the selection of an icon ***positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second,***

displaying second additional information associated with at least one of the patents of the list ***in a third interface separate from the first interface and the second interface*** upon the selection of an additional icon ***positioned in the second interface and associated with one of the patents for drilling down from the second interface to the third interface***

The Examiner request that the applicant direct the Examiner to where there is support for the newly added limitations.

In the Response submitted on 9/21/07 the applicant directs the Examiner to Figures 13, 15-16 and the following quoted excerpts:

Page 29, lines 22-24, wherein the specification discloses:

It should be noted that the electronic versions of the report (those that are displayed utilizing a computer) may include interactive features to further analyze the data by drilling down into selected areas.

Page 32, lines 8-25 (this section read in conjunction with page 31 discloses):

Page 31- line 8 to page 33, line 15:

In a similar manner, it should be noted that the selection of a particular technology group may produce a 2-D graph illustrating a comparison of each of the companies in the specific technology group, where the selection of a "bar" or related icon may indicate a list of patents owned by such company in the particular technology group, and further where the selection of one of the patents may produce specific information regarding such patent; in a manner similar to that will soon be set forth.

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Of course, the interface 1380 of Figure 13B may be skipped by simply clicking the "bars" or related icon of the report 1350 of Figure 13A.

Figure 14 illustrates a method 1400 for providing a graphical user interface such as that of Figure 13 (or even that of Figures 13A-B) which is equipped for reporting on strategic intellectual property management. In operation 1402 a technology category page is displayed depicting a plurality of categories of technology utilizing a graphical user interface.

As set forth in the exemplary graphical user interface 1300 of Figure 13, the technology category page includes statistics regarding a plurality of intellectual property identifiers identifying intellectual property in each of the categories of technology. Also included is competing activity documentation describing a plurality of competing activities in each of the categories of technology. Note operation 1404. Of course, as mentioned before, competing patent data may also be included.

In operation 1406, a user may be allowed to select a summary icon on the graphical user interface 1300. In use, ***such icon may act as a link to another page which sets forth additional information.***

***Figure 15 illustrates an exemplary summary report 1500, in accordance with one embodiment. Such report 1500 may be displayed in response to the selection of the summary icon 1310 of one of the technology categories shown in the interface 1300 of Figure 13. In the alternative, such page may be generated in utilizing the report definition interface 1200 by selecting a particular technology category via pull-down window 1204, selecting all of the intellectual property identifiers via pull-down window 1202, and selecting a summary format type. Of course, the summary report 1500 may be generated in any desired manner.***

As shown, the summary report 1500 lists each of the intellectual property identifiers, each competing patent, and each instance of competing activity associated with the appropriate technology category. For reasons that will soon become apparent, ***each item in the lists 1502 may include a link to an additional page with more information.***

***In an alternate embodiment,*** an intellectual property identifier icon, competing patent icon, or a competing activity documentation icon may be selected separately. In such embodiment, the icons may include the bars 1304-8. Upon the selection of one such icon, only the intellectual property identifiers, competing patents, or competing activity documentation related to the particular technology category may be displayed, the intellectual property identifiers may be displayed. Note operation 1406.

With continuing reference to Figure 14, more information may be displayed regarding the intellectual property, the competing activity, and the competing patents in response to a user request in operation 1408.

In particular, upon a user selecting one of the intellectual property identifiers in the lists 1502, more information relating to such intellectual property may be presented. Figure 16 illustrates an exemplary intellectual property details report 1600, in accordance with one embodiment. As shown, a patent number, status, exemplary claim and figure, etc. may be provided in such report. It should be noted that such intellectual property details report 1600 may also be generated directly utilizing the report definition interface 1200 by selecting a particular intellectual property identifiers via pull-down window 1202, and selecting a details format type.

***Of course, the details report 1600 may be generated in any desired manner.***

Thus, while applicant's disclosure discloses that selection of one of the patents may product specific information regarding such patent, that the electronic version of the report may include interactive feature, a graphical user interface (GUI) which is equipped for reporting on IP management, that the user may be allowed to select a summary icon on the GUI wherein such icon may act as a link to another page which sets forth additional information, that a summary report may be displayed in response to the selection of the summary icon of one of the technology categories or that the page may be generated by selecting a pull-down window, and that the summary report may be generated in any desired manner, applicant's disclosure does not disclose displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second, displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and second interface upon the selection of an additional icon

positioned in the second interface and associated with one of the patents for drilling down from the second interface to the third interface. At most applicant discloses that applicant may be allowed to select a summary icon on the GUI, such icon may act as a link to another page which sets forth additional information and that the summary report lists each of the intellectual property identifiers, each competing patent, etc. and that each item in the lists may include links to an additional page. Applicant also discloses that upon a user selecting one of the intellectual property identifiers, more information relating to the property may be presented. At most, an additional page or information is presented. However, there is no disclosure that the page is separate for the first of second information. Moreover, a page is not another interface or GUI.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-2, 4-13, 18-20 and 44-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The body of the claims have the following step:

storing the manually selected file in association with the at least one identifier by providing ***a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier.***

Second, what does the applicant mean by providing a correspondence between the file and the identifier. What is the applicant identifying as an identifier. Page 8 of



the specification states that an identifier may include a patent number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and/or is associated with intellectual property.

This same step has the following language:

storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus **associating** the manually selected file with the at least one identifier, thus associating the manually selected file with the at least one identifier, **wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents**

What does the applicant mean by associating the file with the identifier?

The applicant has a step of storing the manually entered notes in association with at least one identifier and then a step of allowing a selection of a file. Then the applicant states that a manually selected first file is associated with a first identifier corresponding to a single patent and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents.

First, is the first identifier the same identifier that the notes were stored with?

Secondly, the applicant states that the notes are stored in association with at least one identifier, requiring only one identifier. If there is only one identifier, how can there be a first and second identifier. Are these in addition to the identifier stored with the notes?

Applicant states in the Response submitted on 9/21/07 that **the claim language is**

***purposefully drafted in a broad manner so not to be limited to a scenario where “the first identifier is the same identifier that the notes were stored with”. In other words, it may or may not be and to specify one way or another would be unduly limiting to the claims*** (page 20).

Furthermore, the applicant has a step of allowing the manual selection of a file. If there is only one file, how can there be a first file and a second file? In response to this question, applicant responds by stating that ***regarding the second inquiry, the claims do not require “only one identifier,” but rather “at least one”***. The Examiner asserts that this is non-responsive to the question.

The applicant has a step of ***associating a plurality of patents with the at least one identifier***. Page 8 of the specification states that an identifier may include a patent number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and/or is associated with intellectual property.

Thus, how can a plurality of patents be associated with one patent number? The applicant responds on page 21 of the response that applicant ***respectfully asserts that the claims are not limited to “a plurality of patents [being] associated with one patent number”, as suggested by the Examiner. As noted by the Examiner, applicant's specification as originally filed expressly states that the “identifier may include a patent number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and or is associated with the intellectual property”***. The Examiner asserts that this is non-responsive to the question.

Although applicant states in the Response submitted on 9/21/07 that examples of such terms (“files”, “identifier”, “correspondence”, “associated”, etc) may be found in the figures below (Figure 11).

The applicant states in the preamble that the invention is a method for organizing patents. Then the applicant list the steps of displaying a notes field, storing the manually entered notes in association with an identifier, allowing the selection of a file, storing the file with the identifier and associating a plurality of patents with the identifier.

The applicant then has added the language that “wherein a set of patents is *reported* by – what does the applicant mean by “reported”? What set of patents are being reported? In response to this question, applicant states on page 21 that the ***applicant relies on the plain and ordinary meaning of “reported”***. The Examiner asserts that this is non-responsive to the question.

Applicant then claims displaying first additional information associated with at least a portion of patents of the set in a second interface separate from the first interface upon the selection an positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, the first information including a list of patents of the set associated with one category of technology, displaying a second additional wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, an exemplary figure information; wherein the statistics are displayed in the first interface, the first additional information is displayed in a second interface, and the second additional information is displayed in a third interface.

It is not clear how the set of patents being displayed is connected to the identifier or the file. It is unclear to the Examiner what the applicant is claiming in the claim language. **Applicant has started out with a notes field, storing the notes field with an identifier, selecting a file, storing the file, associating a plurality of patents with at least one identifier** (it is not clear where the plurality of patents come from since there is no search being performed), **making the notes and files and patents accessible by selection of the at least one identifier** (however, where is it in the claim language that the notes, files and patents were ever correlated with one identifier). **Applicant then states that a set of patents is reported** (however, it is not clear what set of patents or if the set of patents relate to any of the steps above), **displaying a technology mapping depicting a plurality of categories of technology** (note that the patents are not mentioned in this displaying step); **displaying statistics regarding a number of patents of the set in each category, displaying additional information in a second interface, wherein the first additional information includes a list of the patents of the set associated with one category of technology** (there is no earlier correlation with the technology mapping depicting at least one category of technology and a listing of patent), **displaying second information associated with at least one of the patents in the list in a third interface** (however, it is unclear where this list even comes from), wherein the second information is selected from the group consisting of a patent number, a status, a claim or a figure. What does this mean? Your first information is information associated with patents and your second information is a patent number, status????).

In response to the above questions, applicant states that the ***claims have been clarified to avoid these issues***. The Examiner disagrees with this assertion.

The applicant states in the claim language “that wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail”. This is unclear.

What does the applicant mean by “made accessible?” Are they transmitted?

In Claims 5 and 6, it is unclear what the applicant means by the language “the at least one identifier is determined utilizing an add icon” or “a modify icon”.

In Claims 8 and 9, it is unclear what the applicant means by the file is selected utilizing a file structure field? What is a file structure field? What does the applicant mean by the file structure field includes a file tree structure?

In Claim 12, it is unclear what the applicant means by the patents associated with the at least one identifier are identified by searching a database of already existing identifiers. This is unclear. It is not clear what the applicant is searching or what the applicant is searching for.

In response to the above questions and statements, the applicant simply states (page 25 of the Response filed on 9/21/07) that applicant ***respectfully relies on the plain and ordinary meaning of such terms. It appears that the Examiner has taken issue with many terms that may be found in the dictionary (and not even technical in nature). In response, applicant again respectfully relies on the plain and ordinary meaning of such terms, as evidenced by relevant dictionary definitions, etc.***

5. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what statutory class applicant is coming in for. A system can be an apparatus, whereby there would need to be some recitation of structure. Applicant identifies the invention as a system comprising a computer readable medium. However, applicant has not claimed the code as being on the medium. Thus, so far, the invention appears to be directed to a system comprising a computer readable medium. It is not clear what applicant identifies as a medium in the specification. Not all computer readable mediums are statutory, i.e., signals, carrier waves. Thus, it is unclear what applicant is claiming in claim 20.

**The Examiner finds that because claim(s) 1-2, 4-13, 18-20, and 44-45 are replete with 35 U.S.C. 112 2<sup>nd</sup> paragraph indefiniteness rejections, it is difficult if not impossible to completely construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of providing art rejections even though the claim(s) contain 35 U.S.C. 112 2<sup>nd</sup> paragraph rejections, the claims are construed and the art is applied *as much as practically possible*.**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4-13, 18-20 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (US 2003/0046307) (hereinafter referred to as Rivette) in view of Barnett et al (2002/0082778) (hereinafter referred to as Barnett).

Referring to Claims 1, 18, 19, 20, 44 and 45

Rivette discloses a method, computer program product embodied on a computer readable medium and a system (page 9 [0289-0291] page 10 [0294]) for organizing patents utilizing a computer-implemented system, comprising:

computer code for performing the steps of the method [0012] [0289], comprising:  
displaying (display unit (1122) page 9 [0292]) a notes field for receiving manually entered notes and receiving the manually entered notes, utilizing the notes field (Fig. 4 Notes Mode (414) (Figure 134 (13408) [1200-1202] [0255-0257] Figs. 125-143 [0314] [0384] [0326]);

storing the manually entered notes in association with at least one identifier (patent number) (Fig. 111; Figure 134 save button [0380-0387]);

receiving the manual selection of a file ( [0373] [0383] Figure 134 (13404);  
storing the manually selected file in association with the at least one identifier (patent number) by providing a correspondence between the file and the at least one

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identifier wherein a manually selected first file is capable of being associated with a first identifier (patent number) corresponding to a single patent and a manually selected second file is associated with a second identifier corresponding to a group (Figures 117-119 and Figures 133 and 134 (13304) Analog Special Effects; [0264] a group is a data structure that includes a collection of patents [0326-0329] [0330-0344] [0373-0379] [0393]) ; and

associating a plurality of patents with the at least one identifier (Figure 122; [0265]);

wherein the manually entered notes and the patents are accessible by subsequent selection of the at least one identified (Figures 117-120, 122, 133, 134, [1157-1162] [0373-0387] [0329])

wherein a set of patents is reported by;

displaying a mapping depicting a plurality of technology utilizing a graphical user interface (page 2 [0025], page 7 [0262-0268]; pages 8-9 [0277] [0848] Figure 18 [1101-1110]),

displaying statistics regarding a number of the patents of the set in each category of technology ([0025] [0262] [0266] [0277] Figure 102-105),

displaying first additional information associated with at least a portion of the patents of the set upon the selection of an icon (Figs. 148, 117-120, 122, 133, 134, 153 [0377] [1157-1162]),



wherein the first additional information includes a list of patents of the set associated with one of the categories of technology ( [0020], [0262, 0264-0268], [0331] [1027-1028]),

displaying additional information associated with at least one of the patents of the list upon the selection of an additional icon, wherein the second additional information is selected from a group consisting of a patent number, status, an exemplary claim, and an exemplary figure ([0377], Fig. 7, Fig. 45 (4512), Figs. 111-112; Figure 148; [1157-1162]),

wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface, and the second additional information is displayed in a third interface (Figs. 111-112, see also Figures 117-134);.

wherein said method is at least in part carried out utilizing the computer implemented system (Fig. 3-4); and wherein the method supports a drill down technique ([0270]).

Rivette displays interfaces showing different information relating to patents, wherein the interfaces have three interfaces (Figs. 57, 125, 117). Rivette discloses technology and competitor analysis [0262—0268]. However, Rivette does not explicitly disclose displaying a technology mapping (although page 2 [0025] does not exclude technology mapping) depicting at least one category of technology or wherein the first additional information includes a list of patents of the set associated with one category of technology, or wherein there is second additional information selected from the group consisting of a patent number, status, exemplary claim or figure, or wherein the

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statistics are displayed in a first interface, the first additional information is displayed in the second interface, and the second additional information is displayed in a third interface.

However, Barnett disclose depicting at least one category of technology and the first additional information includes a list of patents of the set associated with one category of technology, and wherein there is second additional information selected from the group consisting of a patent number, status, exemplary claim or figure, and wherein the statistics are displayed (Figures 21-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the patent method and system of Rivette the technology mapping disclosed in Barnett to aid in strategic and tactical business decisions.

The Examiner notes the following as to interpreting the claim limitations:

The statement that "wherein the manually entered notes, at least one of the manually selected files and the patents are accessible by subsequent selection of the at least one identifier" does not provide for a positive recitation of accessing the notes, files or patents, not is there a positive recitation of the at least one identifier being selected and thus this language is merely non-functional descriptive data.

The recitation of "wherein the notes field allows a user to cut and paste notes" is only descriptive of the notes field. There is no positive recitation of the user cutting and pasting notes in the notes field.

The recitation "wherein the file is selected utilizing a file structure field including a file tree structure that allows a user to browse various folders where files have been

previously stored, where the file structure is displayed simultaneously with the notes field on the same interface, the file selected utilizing the file tree-structure including information from a source separate from the patents" does not provide a positive recitation of a file being selected. The fact that the file structure field includes a file tree structure is non-functional descriptive data. The fact that the file tree structure allows a user to browse various folders is not a positive recitation of folders actually being browsed. There is no positive recitation of displaying the file structure simultaneously with the notes field. Moreover, the fact that the file tree structure includes information from a source separate from the patents is non-functional descriptive data.

As for the limitation of "wherein the patents associated with the at least one identifier are identified by searching a database including a comprehensive database of all patents issued by at least one government agency is non-functional descriptive data.

As for the limitation "wherein a set of the patents is reported by:

displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface,

displaying statistics regarding a number of patents of the set in each of the categories of technology in a first interface;

displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the

additional information includes a list of patents of the set associated with the one of the categories of technology;

displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, wherein the second additional information includes at least one of a patent number, a status, an exemplary claim and an exemplary figure" the Examiner asserts the following:

All that is required by the claim limitations is displaying a technology mapping depicting a plurality of categories of technology, displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface".

Moreover, many of the differences between the prior art and applicant's claimed invention are deemed to be non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85,217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a

new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data identifying what is displayed in the record adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying what is in the record does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and

because the subjective interpretation of the data does not patentably distinguish the claimed invention.

The fact that the notes and files are made accessible to other parties utilizing e-mail is old and well known. Furthermore, because of the way this step is worded, it could encompass a person e-mailing another person to come look at the notes and files.

E-mail, to one ordinarily skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be attaching a file and emailing it to another computer or simply having a hyperlink in the email. Industry has utilized computers for years as a way of tracking and documenting information. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize e-mail as a way of communication since it is fast and efficient and reliable way of communication.

Furthermore, applicant's disclosure states that the summary report 1500 may be generated in any desired manner and the details of report 1600 may be generated in any desired manner (page 32, lines 14-15 and page 33, line 15).

Thus, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to display the report as Rivette and Barnett have since applicant has not disclosed that displaying the report as applicant now claims provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected applicant's

invention to perform equally well with the reports and the details of the reports being generated in any desired manner, as set forth by application.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display the reports and the details of the reports in any desired manner since, as applicant admits above, there is no advantage, particular purpose, or solution to a problem being solved.

Referring to Claims 2, 4-6:

Rivette discloses a method wherein the at least one identifier is determined by selecting an already existing identifier (Figure 147 and 117-120, 133-134).

Furthermore, it is old and well known to have a method wherein the at least one identifier is determined by selecting an already existing identifier utilizing a pull-down menu. For example, while doing a search in East, the Examiner may use a number from a pull down menu to select a search and then store this search as a new search.

It is also old and well known to add a file and thus create a new file with a new identifier or modify the name to a file thus creating a new identifier.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a pull-down menu, an add icon or a modify icon to the disclosure of Rivette so as to allow for easy access to the identifiers.

Referring to Claims 7-11:

Rivette discloses wherein a notes field allows a user to cut and paste notes (Fig. 58, Fig. 137 (Note ToolBar (13706)), wherein the file is selected utilizing a file structure field (Fig. 58), wherein the file structure field includes a file tree structure (Fig. 58),

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wherein the file structure filed allows a user to browse various folders where files have been previously stored, Fig. 58), and wherein the file structure is displayed simultaneously with the notes filed on the same interface (Fig. 58 Figures 117-120, 133-134, [1157-1162], [1193].

Referring to Claim 12:

Rivette discloses wherein the patents associated with the at least one identifier are identified by searching a database of already existing identifiers (Fig. 6, Figs. 12B-12L, Figure 148).

Referring to Claim 13:

Rivette discloses wherein the database is a comprehensive database of all patents issued by at least one government agency (Document database [0310-0311], Patent bibliographic database [0318-0322] [0806-0807] [0418-0422] [0388-0417])

## **(10) Response to Argument**

### **112,1st**

With respect to the traversal of the 112,1<sup>st</sup> rejection, it is not found to be persuasive. The appellant has argued that the displaying of a another page in response to the selection of an icon on a 1<sup>st</sup> given page supports the limitation that information is displayed in a 2<sup>nd</sup> interface that is separate from the 1<sup>st</sup> interface (as well as 3<sup>rd</sup> interface). The Appellant has referred to figure 13 which is disclosed as being a



graphical user interface 1300. The report shown in figure 15 is not disclosed as being a separate interface from interface 1300, it is just disclosed as being another page.

Applicant seems to be arguing that because figure 13 is called an interface that any other pages can also be called interfaces. The specification as originally filed did not use language that called each individual page a separate interface from each other and applicant's argument is not taken as persuasive. The displaying of an additional page is not taken as constituting more than one interface that is separate from the others. This does not seem to be supported by the original disclosure. The examiner does not believe that a separate page is considered to be a separate interface (GUI) as has been argued.

#### **112,2nd**

With respect to the 112,2<sup>nd</sup> paragraph rejection, the argument is not persuasive, with the exception that with respect to the limitation of a "file" and what that means as well as what is meant by "accessible", those portions of the rejection has been withdrawn and overcome in view of the arguments. The issue of the "technology mapping" and where the mapping comes from has been removed from the rejection as it has been overcome.

With respect to the issue of what is meant by the language of "providing a correspondence between the file and the at least one identifier", the appellant has not explained or provided any argument with respect to what this language means. The same seems true of for the issue regarding the identifier and what scope this term has.

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Applicant seems to only argued that the appellant "relies on the plain and ordinary meaning of "file" and "identifier", "correspondence", associated, etc.". This is not addressing the issue that was set forth by the examiner. The appellant has not even provided the "plain and ordinary meaning" of these terms so it is not clear what the position of the appellant is. The 112 rejection for these issues will be maintained due to a lack of a persuasive traversal.

With respect to the issue of the identifier and the issues set forth in the 112 rejection, the argument is not persuasive. Appellant argues that claim language is "purposely drafted in a broad manner so not to be limited to a scenario where the first identifier is the same identifier that the notes are stored with". In response to this statement, it seems that the claim recites "at least one identifier" and "a first identifier" and a "second identifier", then it is claimed that there is computer code for associating a plurality of patents with "at least one identifier". Appellant seems to argue that each identifier can actually be the same identifier or it may not be? This does not seem to agree with the claim language where it seems that each identifier is separately recited so that the claim requires anywhere from 4 identifiers to an open ended upper limit. The examiner does not see an argument from appellant other than arguing that the claim language is broad, which is not persuasive.

With respect to the issue of the file and how many there are, the argument does not seem to be persuasive because all appellant has argued is that the claim language recites "receiving the manual selection of a file" and has argued that it does not recite "only one file" as asserted by the examiner. In response, the claim scope appears to

recite one file and then the question is how can there be a 1<sup>st</sup> and 2<sup>nd</sup> file if there is only one in the scope of the claim. This issue does not seem to have been addressed by the appellant.

With respect to the issue regarding the associating a plurality of patents with at least one identifier, appellant has stated that the claims do not have a scope that allows for the identifier to be associated with just one patent number. In the Final rejection the examiner of record posed the issue of how the plurality of patents can be associated with one patent number and this issue does not seem to have been specifically argued by appellant. The argument found on page 26 of the response is not quite clear to the instant examiner as it does not seem to address the issue set forth by the examiner in the Final rejection.

With respect to what is meant by reciting that a set of patents is “reported”, appellant has relied upon the plain and ordinary meaning of this term, but has failed to provide the examiner with any actual definition to consider. What does appellant feel is the plain and ordinary meaning of this term? Appellant has not explained or sufficiently rebutted the position of the examiner to find the argument persuasive.

On pages 29 to 30 of the Appeal Brief, appellant argues the 112 rejection with respect to the issue of the identifier and what the scope of the claim language means, the appellant has not actually provided any argument for this issue. On page 29 appellant repeats the portion of the Final rejection that deals with this 112,2nd rejection, and on page 30 it is argued that on 9/21/07 the claims were amended to overcome this

issue. This appears to be the only comments made regarding this portion of the 112 rejection. The argument is not persuasive.

On page 31 of the Appeal Brief appellant argues that appellant has relied upon the plain and ordinary meaning of this term, but has failed to provide the examiner with any actual definition to consider. What does appellant feel is the plain and ordinary meaning of this term? Appellant has not explained or sufficiently rebutted the position of the examiner to find the argument persuasive.

For claims 5 and 6, the argument is not persuasive. The examiner stated that it was not clear as to what is meant by "the at least one identifier is determined utilizing an add icon or a modify icon. The response from appellant is reliance upon the plain and ordinary meaning of certain terms without actually providing any explanation as to what the plain and ordinary meanings actually are. No definitions have been provided so it is not clear what the position of the appellant actually is.

For claims 8 and 9, the issue set forth by the examiner was what was meant by "a file structure field" and a "file tree structure". In response appellant again argues that they have relied upon the plain and ordinary meaning of certain terms without actually providing any explanation as to what the plain and ordinary meanings actually are. No definitions have been provided so it is not clear what the position of the appellant actually is.

For claim 12, appellant again argues that they have relied upon the plain and ordinary meaning of certain terms without actually providing any explanation as to what

the plain and ordinary meanings actually are. No definitions have been provided so it is not clear what the position of the appellant actually is.

For claim 20, the issue of whether or not the claim scope includes a storage medium such as a signal or a carrier wave has not been addressed by the appellant. Also not addressed was the issue of whether or not the computer code was actually stored on the storage medium. If the computer code is not recited as being stored on the storage medium then what is the system made up of? The examiner can read that the claim recites "a system comprising" and "a computer readable medium", so just repeating what is already known is not addressing the issue at hand.

### **Prior Art Rejections**

On page 34 of the Appeal Brief, appellant argues the limitation regarding the displaying of statistics in a 1<sup>st</sup> and 2<sup>nd</sup> interface as claimed. On the bottom of page 34 it is stated that Rivette discloses the displaying of information in 1st and 2nd windows. As far as the display of information goes, Rivette teaches the use of multiple windows which is seen as satisfying the claimed 1st and 2nd interfaces because the instant specification discloses the use of more than one window, just like the prior art. Regarding the limitation of the display of statistics, the instant examiner sees the kind of data that is displayed as being directed to non-functional descriptive material as this is just the display of a broad recitation to data. The scope of the term "statistics regarding a number of patents" is broad language that can be satisfied by the display of any data regarding a number of patents. The argument that the prior art does not display

“statistics” is not persuasive as this term is broad and because the prior art displays information about patents, this is seen as satisfying what is claimed. Patent text, patent notes, and patent images are considered to satisfy what is claimed as this is patent information regarding patents.

With respect to the argument concerning the “drilling down from the first interface to the second interface, etc.”, it is not persuasive. Appellant states that Rivette discloses viewing parent and child groups with or without an original group, in addition to data drilling, but it is not clear as to why the language of Rivette does not satisfy what is claimed. The display of information in interfaces as claimed has already been addressed and as best understood by the examiner, with respect to the drilling down limitation, the prior art satisfies what is claimed.

On page 37 appellant has argued that prior art disclosing interfaces showing different patent information fails to disclosed displaying statistics in a first interface, and additional information in a 2nd interface, third interface, etc.. The examiner disagrees. As stated previously, applicant's specification discloses the use of separate windows not interfaces, so this extent the prior art satisfies what is claimed because the prior art teaches the use of different windows. As far as the data that is displayed, the prior art is seen as satisfying the data as previously addressed.

With respect to the technology mapping, the examiner has relied upon Barnett for this limitation and the appellant has only argued that because Rivette does not exclude technology mapping does not mean that it discloses or teaches technology mapping. The secondary reference to Barnett is what was relied upon for a teaching of the

technology mapping and applicant has only argued the primary reference, which is not persuasive. There does not appear to be any other discussion or argument concerning this limitation.

On page 38 appellant argues that the examiner has failed to show "all" of the claimed elements in the prior art. Appellant then repeats the limitation regarding the use of two interfaces for the displaying of statistics, which has already been addressed by the examiner.

On page 39 appellant implies that the claimed invention provides some sort of synergistic result; however, the examiner notes that no evidence or explanation of what the synergistic result is has been provided for review. No showing of any "synergistic" result has been made.

On page 39, the issue of certain data in the claims being considered non-functional descriptive material was discussed. Appellant has cited MPEP 2106 with respect to non-functional descriptive material. This section of the MPEP deals with 35 USC 101 issues and is not addressing the issue of claim interpretation for prior art purposes regarding the issue of non-functional descriptive material. The issue in the 35 USC 103 rejection is not dealing with the issue of a statutory claim so appellants argument is not persuasive as it is addressing a 101 issue when the issue at hand is claim interpretation and 35 USC 103. On page 40 appellant argues that the displaying of information in more than one "interface" (really a window) is a functional relationship so the data should not be considered as non-functional. The selection of an icon does not mean that that displayed data is functional; it may very well be non-functional

descriptive material that is displayed. Just because one selects an icon to display more data does not automatically render that data as functional. That argument is not persuasive. With respect to the actual data displayed, it is still seen as being directed to non-functional descriptive material as it is just descriptive in nature and merely describes certain patent information. The data stored and displayed by the system is merely stored and retrieved and this does not present a functional relationship between the system and what is displayed. The argument is not persuasive.

With respect to the issue of the files and patents being accessible by selection of an identifier, appellant seems to argue that this step is required in the claim. The examiner disagrees. The term "accessible" means that the files and patents are able to be accessed, nothing more. This is not a recitation to a step of actually accessing the files and patents. Appellant is only reciting the ability for the files and patents to be accessed, not an actual step of accessing them. Additionally, the instant examiner sees this as a moot point anyway because the prior art clearly teaches that the files and patents can be accessed by a user. The argument is not persuasive.

With respect to the user being able to cut and paste in the notes field, this is another limitation directed to the ability for something to happen and is not a recitation to the actual act occurring. Allowing something to happen is not the same as that something actually happening, there is a difference. The argument is not persuasive.

With respect to the file structure field and the file tree structure, the argument is not persuasive. The prior art is seen as satisfying this limitation. The only thing claimed is the selection of a file and the language about the user browsing, etc., is not seen as



positively being claimed. As stated previously to allow something to occur is not the same as that something actually occurring.

With respect to the database being recited as “issued by at least one government agency”, this is directed to non-functional descriptive material as it does not matter who issued the database. All that matters is that a database is searched, the entity that issue the database or created it is language directed to non-functional descriptive material.

On the bottom of page 42 to the middle of page 43 of the Appeal Brief, appellant cites a portion of the action that the examiner wrote and then simply states that the language should be read as recited and is not limited to displaying a technology mapping.... and displaying statistics..” as suggested by the examiner. It is not clear as to what this argument is trying to convey. It does not seem to be explained why the prior art does not disclose what is claimed.

With respect to the argument on pages 43-44 and the issue of the data being displayed being considered as non-functional, this has already been addressed and is found non-persuasive as previously set forth. The limitation regarding the displaying of statistics on 1st,2nd,3rd interfaces has already been addressed and is essentially a repeat of a previously made argument.

On page 45 of the Appeal Brief the appellant argues that the examiner has incorrectly taken “official notice” and requests a citation of a reference. The instant examiner has reviewed the Final rejection and does not see where any official notice was taken on the record with respect to the issue of the type of data being displayed as

being obvious. The argument is not persuasive. Additionally, because the data that is recited as being displayed regarding patents is directed to non-functional descriptive material, it follows that when one is dealing with patents, one of ordinary skill in the art can select and choose what the data is that is to be displayed and this amounts to a nothing more than a selection of what kind of non-functional descriptive material is to be displayed.

With respect to pages 45-46 of the Appeal Brief and with respect to the issue of the manner by which a report is displayed, the examiner stated that it would have been obvious to display the report as is done in the prior art because the appellant has not disclosed that displaying the report in the manner claimed is solving any particular problem or produces any unexpected result. In response the appellant argues that the examiner has incorrectly taken "official notice" and that the examiner has not considered all claimed limitations. The instant examiner disagrees and does not see where the examiner has taken official notice in the Final rejection and does not see why the prior art rejection is in error with respect to this issue. What is the criticality of what is claimed?

With respect to the use of email and the limitation regarding that the files are accessible by email, the argument is not persuasive. What is claimed is simply the use of email, which is something that is very well known to one of ordinary skill in the art. To simply recite that files and patents are accessible (able to be accessed) by email is just reciting that ability for those files to be sent by email. To start with, the files and patents of the prior art are accessible so that part of the language is satisfied. To minor

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difference of using email is something that involves no more than ordinary skill in the art and is well within the knowledge of one of ordinary skill in the art. With respect to the argument that making files and patents accessible by email does not allow for the files and patents to be sent by email, this is not persuasive. One way to make the files and patents accessible to another is to email them by using email. This situation satisfies what is claimed.

For claim 2, the argument is not persuasive. Appellant has argued that figure 147 of Rivette does not show what is claimed, which is wherein at least one identifier is determined by selecting another existing identifier. The "existing identifier" can be interpreted to be the selection of any identifier, which upon selection determines what is to be displayed (which includes notes, etc.). This is what is shown in figure 147 and seems to satisfy what is claimed. Also, with respect to claim 2 this is not even a method claim so arguing the manner by which an identifier is selected is not seen as receiving much weight as claim 2 is directed to the computer program product, not a method.

With respect to claim 4, appellant has relied upon the argument that Rivette does not disclose the selection of an identifier by selecting an already existing identifier. The examiner believes that the issue with respect to claim 4 was relating to the use of a pull down menu and this individual aspect does not seem to have been argued by appellant. If the limitation of the selection of an identifier is in the prior art, then why is the use of pull down menus to aid in the selection not obvious to one of ordinary skill in the art? The use of pull down menus is very well known in the art.

For claims 5,6, with respect to the "add icon" and the "modify icon", appellant has argued that Rivette does not disclose the "at least one identifier" in the context claimed. This is not persuasive. Appellant seems to argue that because the identifier is not in the prior art then the issue of the add icon cannot be obvious. This does not seem to be addressing the issue of whether or not it is obvious to use an add icon.

With respect to claim 7, all that is recited is that the notes field allows for one to cut and paste notes. Cutting and pasting is a very basis concept to word processing and the prior art satisfies what is claimed. The fact that the prior art has a note field satisfies what is claimed because if one wanted to they could cut and paste from the notes field into Microsoft Word <sup>TM</sup>. Nothing in the prior art would stop someone from using a word processing program to cut and past from the notes filed. Appellant has only recited the ability to do this in the notes field and this is a very basis thing in word processing and the prior art has the ability to do what is claimed. As stated previously, appellant has not actually recited cutting and pasting, just the ability to cut and paste, there is a difference between the two.

That is the conclusion of appellant's arguments.

#### **(11) Related Proceeding(s) Appendix**

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Dennis Ruhl/

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